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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,508	05/26/2000	Richard T. McNamar	056980/0102	7988

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/578,508

Applicant(s)

MCNAMAR ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-141 is/are pending in the application.
- 4a) Of the above claim(s) 54-60, 62-65 and 70-141 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53, 61 and 66-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This is in response to Applicant's communication dated July 3, 2003. Election of claims 1-53, 61 and 66-69 with traverse by the Applicants is acknowledged. Also cancellation of claims 54-60, 62-65, 71-139 and 141 has been noted. Arguments with regards to restriction/election have been considered but are not persuasive. Accordingly all claims other than those elected are withdrawn from consideration as being drawn to the non-elected group. Applicants in replying to this office action are advised to cancel the remaining non-elected claims. Elected claims 1- 53, 61 and 66-69 have been examined. The rejections are stated below.

#### ***Drawings***

2. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 50-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by

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"such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, independent claim 1 recites the narrow limitation "providing a client with an Integrated Financial management account", whereas dependent claim also recites "providing financial services" which is a broader limitation. Dependent claims cannot have a scope broader than the claim they are dependent on. Similarly claims 51-53 are dependent on claim 50 and hence suffer from the same improper dependency. Cancellation of claims 50-53 is advised in reply to this office action.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-49, 61 and 66-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over et al Weiss et al (US Patent 6,131,810)

With reference to claim 1, Weiss teaches a computer implemented method of providing a client with an integrated financial management account, the integrated financial management account including an investment component linked to a loan component, the method comprising

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the steps of: receiving application data for the integrated financial management account (See Weiss Claim 1); setting up the integrated financial management account with investment component data and loan component data associated with an account file (See Weiss abstract and claims 5 and 8); contemporaneous with setting up the integrated financial management account in the account file, associating an investment asset to the investment component data in the account file in order to credit the client with the investment asset in the investment component of the integrated financial management account (See Weiss Column 4 lines 37-39); and qualifying the client for a loan in the loan component of the integrated financial management account and recording the qualification in the account file (See Weiss Column 14 lines 58-67).

Weiss does not explicitly teach the steps of disbursing the proceeds of the loan component into the investment component by storing a value of the proceeds in the investment component data in the account file after successful loan qualification, or after unsuccessful qualification, removing the association of the investment asset to the investment component data in the account file.

Official notice is taken that the steps of disbursing the proceeds of the loan component into the investment component by storing a value of the proceeds in the investment component data in the account file after successful loan qualification, or after unsuccessful qualification, removing the association of the investment asset to the investment component data in the account file are old and well known in the art. These steps help the account holders to start earning returns on their investment as soon as the loan proceeds are disbursed and also helps the system avoid storing unnecessary investment data if the loan is rejected.

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It would have been obvious to one with ordinary skill in the art at the time of the current invention to include the steps of disbursing the proceeds of the loan component into the investment component by storing a value of the proceeds in the investment component data in the account file after successful loan qualification, or after unsuccessful qualification, removing the association of the investment asset to the investment component data in the account file to the invention of Weiss. The combination of the disclosures taken as a whole suggests that users would have benefited from being able to start earning returns on their investment as soon as the loan proceeds are disbursed and the system would have benefited from avoiding having to store unnecessary investment data if the loan is rejected.

With reference to claims 2-49, 61 and 66-69, Weiss discloses a computer-implemented method of claim 1 as discussed above. The limitations in these claims are either taught by Weiss or official notice is taken that such limitations are old and well known in the art and would have been obvious to one with ordinary skill in the art at the time of the invention. These limitations provide the account holders with the convenience of dealing with one account in a user-friendly way, integrated record keeping and also saved them valuable time and money.

It would have been obvious to one with ordinary skill in the art at the time of the current invention to include the limitations in claims 2-49, 61 and 66-69 to the invention of Weiss. The combination of the disclosures taken as a whole suggests that users would have benefited from the convenience of dealing with one account in a user-friendly way, integrated record keeping and savings of time and money.

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***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
September 21, 2003

Richard Weisberger  
Primary Examiner

